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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/816,152

03/26/2001

William A. Knaus

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6441

7590

01/31/2006

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EXAMINER

NAJARIAN, LENA

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/816,152

Applicant(s)

KNAUS ET AL.

Examiner

Lena Najarian

Art Unit

3626

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 01 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

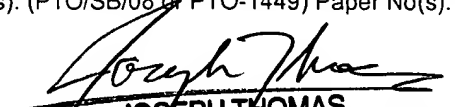
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: NONE.  
Claim(s) objected to: NONE.  
Claim(s) rejected: 1-59.  
Claim(s) withdrawn from consideration: NONE.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 20050923  
13. ☐ Other: \_\_\_\_\_

  
**JOSEPH THOMAS**  
**SUPERVISORY PATENT EXAMINER**

Continuation of 3. The proposed amendment to claim 40 changes the scope of the claim from that previously presented in reciting a new class of invention and requires further consideration.

Continuation of 11.

(1) Applicant argues at page 14 that claim 37 is not a method claim, but a product-by-process claim and is in proper form.

As per the first argument, applying the infringement test to determine whether a dependent claim is proper, it is conceivable that the product claim can be infringed without infringing the base method claim if the product can be made by a method other than that recited in the base method claim. Thus, claim 37 fails the infringement test since it is directed to both a method (through dependency) and a product (see page 2 of Non-Final Rejection mailed 6/17/05). Note also MPEP 2173.05(p).

(2) At page 14 Applicant states that claim 40 is now statutory.

As per this remark, Applicant is arguing features that have not been entered.

(3) At page 15, Applicant argues that Segal and Malik are not prior art in view of Applicant's Rule 131 Declaration.

The Examiner would like to thank the Applicant for providing a claim chart to assist the Examiner. However, the 131 Declaration is insufficient to remove the applied references since the "Claim Chart" does not adequately match the claims with the averred statements for at least three features. For example, clear support for the claimed features of: (i) broad-band, (ii) non-repudiation, and (iii) the "only" phrase (in line 10 of claim 1) were not found in the cited passages of Applicant's exhibits.

(4) At page 16, Applicant points to a passage in the MPEP to argue that the affidavit may be compared with the prior art reference. At page 17, Applicant points to another passage of the MPEP to argue that a comparison between the affidavit and the PTO's interpretation of the invention is permissible.

The Examiner agrees that these passages are in the MPEP, however they have been taken out of context. The Examiner never required a showing of identical subject matter to the applied references. Applicant fails to sufficiently show that his invention "as claimed" was completed prior to the date of the applied references. The issue is not whether the affidavit shows more than what the references show, but rather, what invention did Applicant possess as of the dates averred. There is no clear nexus between several of the claimed features and the averred exhibits. For example, with respect to the "non-repudiation" feature recited in claim 1, Applicant points to various paragraphs of pp. 4, 8, 10, 11, 12, 13, 17, and 24 of exhibits yet, none of the cited passages directly refers to a "non-repudiation" characteristic. Similar analysis holds for at least the features of "broad-band" (claim 1, preamble) and "transmitted in whole or in part only to that person..." (claim 1, line 10).

(5) At pages 18-20, Applicant argues that the Examiner is construing claim terms, but is doing so without referring to Applicant's specification.

As per this argument, the Examiner gave each term the broadest reasonable interpretation in light of the Applicant's specification. The Examiner disagrees that she did not refer to the specification. The Examiner did refer to the specification, but was unable to find any definition given with precision, clarity, and deliberateness to warrant the meanings currently argued by Applicant. For example, at page 19, note the passages relied upon by Applicant for "certification." Applicant's definition of "certification" contains exemplary or non-committal phraseology such as "may be," "may," and "for example." Similar analysis applies for Applicant's definition of "non-repudiation." Note also MPEP 2111.01 and 2173.05(a).

(6) At pages 20-21, Applicant argues that the affidavit removes obvious-type prior art.

As per this argument, the Examiner respectfully disagrees, since the issue is not whether Applicant shows more than what the references show, but rather does the affidavit clearly demonstrate possession of the claimed invention. In addition, it is noted that the cited portion of the MPEP refers to a situation where there is no citation of a reference for a particular feature or modification. This is not the case at present, since the Examiner has pointed to specific passages of the applied reference for each and every limitation.

(7) At page 21, Applicant argues that Malik has been removed as prior art.

The Examiner disagrees. See reasons above in part (3).